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BINGHAM MCCUTCHEN LLP			GISHNOCK, NIKOLAI A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/675,155	<b>Applicant(s)</b> MURPHY ET AL.
	<b>Examiner</b> Nikolai A. Gishnock	<b>Art Unit</b> 3715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 05 December 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-32,35-37,39-51,54-56 and 58-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-32,35-37,39-51,54-56 and 58-72 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 September 2000 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

In response to Applicant's amendments filed 12/5/2008, claims 14, 15, 19, 33, 34, 38, 52, 53, & 57 are cancelled. Claims 1-13, 16-18, 2-32, 35-37, 39-51, 54-56, & 58-72 are pending.

***Claim Objections***

1. Claim 66 is objected to because of the following informalities: Claim 66 is a duplicate of claim 61. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8, 27, & 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8, 27, & 46 recite the limitation, "wherein the storing includes a second set of administrative instructions". It is unclear whether this storing refers to the storing of training progress and performance data of claims 4, 23, & 42, or the storing of generated documents in a database of claims 7, 26, & 45.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 9-12, 16-18, 20-25, 28-31, 35-37, 39-44, 47-50, 54-56, & 58-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Ghosh et al. (US 2001/0032094 A1), hereinafter known as Ghosh.

6. Ghosh discloses a system and method of doing business for providing personalized business information to users, comprising: identifying employer business information requirements for respective user job functions (various entities requiring insurance services can access the several databases of the present invention to verify that a particular agent meets the requirements for their needs, or to locate an agent which meets all the requirements that the particular entity has in mind. The system is designed to capture information for tracking licensing requirements for both insurance and securities businesses, Para. 0015) wherein the employer business information requirements for respective user job functions is information for use in performing the respective user job functions as determined by an employer (insurance agents are required to be licensed in each state in which they conduct business, Para. 0006); creating a profile (agent details) specifically for a user defining the user's job function (information on agent employment) and including any professional licenses held by the user (licensing status) and any critical dates (appointment status; Agent details includes information about Agent profile, licensing status, appointment status and CE {Continuing Education} certification requirement status and other related information. The information in agent details is used by LIS {Licensing Information System} to assure compliance with state requirements and to fill in information regarding a particular agency employing one or more agents, Para. 0033); determining personalized business information to provide to the user that is specific to a set of

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activities that the user was specifically employed to perform (LIS permits a user to view and update information regarding an agent's license in agent details, Para. 0040) based on the created profile (agent details includes an agent profile. Agent profile includes information about an agent such as social security number, full name, employee ID number, contact information and so forth, Para. 0039), the employer's business information requirements for the user's job function (An agent can be licensed to deal in securities as well as offer insurance services. This licensing information is included in agent details. The detail information with respect to securities includes all the exams that were taken by an agent to meet securities requirements and dates of examination and status of results approved, Para. 0044), and at least one professional license held by the user (Agent licensing information includes such items as license status, states in which the agent is licensed, license numbers, the issue date of the license, the effective date of the license, license information for any agency to which the agent belongs, agency license renewal dates and so forth, Para. 0040); providing the personalized business information to the user (Reports in LIS are also available to satisfy agent and agency reporting requirements, Para. 0075-0077), wherein the personalized business information includes at least a first segment of information operable to navigate the user to a second segment of information stored at location remote from the first segment of information (Reports can have fields which are tied to information contained in system components, so that an changes in system information, occurring as a result of an update, for example, are reflected in later generated reports. The various parts of a report, such as tables of information, can be populated with information resulting from a search or query conducted on the various system components. Because LIS can exist in a distributed form on a local or wide area network, reports can draw information from a variety of sources related to areas of functionality, Para. 0076), and providing update notifications specifying that there has been an update to at least some of the personalized

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business information provided to the user (updates to the system information which causes changes in particular data items will initiate a section of executable code which provides a response to the change. Responses can include prompting the user for entry of an amount of money for a check request after notification of positive exam results. As dates change with progressing time, agents facing expiration dates or renewal requirements will be notified in response to a calculated date differential of, for example, 60 days before an expiration deadline. A change in state licensing requirements may provoke a notification to any agent licensed in that particular state, Para. 0059; see also Para. 0071) [Claims 1, 20, & 39].

7. Ghosh discloses generating personal training activity data (reports) associated with use of provided personalized professional training (Report details includes functionality and information for creating reports and for printing reports related to a particular topic. Reports can be generated by LIS using report details for any number of types of information available in the system, including tax and licensing information, Para. 0036; these types of information which can be reported are understood to include agent details, especially continuing education requirements), the personal training activity data (agent CE information) including training progress data and training performance data (Agent CE information is also tracked in agent details. CE information lists the CE completed by an agent and includes such items as the course name, the course number, sponsor for the class, sponsor number, the state for which the course was completed, the credits achieved and so forth. LIS displays the courses taken and the requirements satisfied by the courses, Para. 0042; requirements satisfied by the courses are understood to be training progress, and credits achieved are understood to be training performance), wherein the coursework of the personalized training is provided based on the created profile (ad-hoc reports may be created by the user to encompass individualized reporting needs. The ad-hoc reports may use any of the information in LIS in various formats as

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the user desires; Para. 0036; it is understood that the reporting details are stored in the agent profile, see Figure 3, Item 32) [Claims 2, 21, & 40].

8. Ghosh discloses recording [Claims 3, 22, & 41] and storing [Claims 4, 23, & 42 training progress data and training performance data (LIS includes a system maintenance and configuration component, which provides an administrator with security access for performing maintenance functions. Typical maintenance functions include adding or deleting users, modifying user permissions, entering or modifying records related to CE instruction and CE providers, entering or modifying state specific licensing requirements, and so forth, Para. 0032; Agent CE information is selectable for viewing, editing or reporting purposes through a CE details screen. The CE classes taken by an agent, or group of agents, are recorded and updated to provide a record which permits a comparison against state CE requirements, Para. 0065) [Claims 3, 4, 22, 23, 41, & 42].

9. Ghosh discloses generating documents based on the recorded training progress data and training performance data (ad-hoc user reports, Reports can have fields which are tied to information contained in system components, so that changes in system information, occurring as a result of an update, for example, are reflected in later generated reports. The various parts of a report, such as tables of information, can be populated with information resulting from a search or query conducted on the various system components. Because LIS can exist in a distributed form on a local or wide area network, reports can draw information from a variety of sources related to areas of functionality. For example, financial information can be coupled with licensing information and CE requirements to advise a decision on obtaining CE instruction within a budget, Para. 0075-0077) [Claims 5, 24, & 43].

10. Ghosh discloses obtaining a first set of administrative instructions (report details), and wherein the generating of documents includes generating the documents in accordance with the

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first set of administrative instructions (At a user command, or if set for automatic generation, reports are created for submission to appropriate state authorities to satisfy various requirements. Requirements which may be met by submission of these reports can include tax filing statements, state residency and corporation reporting laws, and issues related to the insurance or securities industry mandated by local and federal authorities. Each of these reports can be updated with information as rules or laws change, or in response to changes in agent details 30 or agency details, Para. 0075-0077; it is understood that the report details stored in the agent or agency details are administrative instructions, obtained from a user, for generating documents accordingly; see also Para 0055) [Claims 6, 25, & 44].

11. Ghosh discloses wherein the personalized business information includes knowledge types (a user screen for LIS operates on a flexible and user-friendly basis to provide an ergonomic interface. *Agent, agency, state, CE and report information* is available at user screen through intuitive graphical symbols and labels, Para. 0056, see also Figure 8, Item 64; This information is understood to be types of knowledge) [Claims 9, 28, & 47].

12. Ghosh discloses linking the knowledge types to one another (LIS permits a user to access agent profile to obtain particular information related to an agent or group of agents. The user may, depending upon security permissions, search for agents based on specific criteria, select one or more agents from the search results, view complete agent profiles and compose reports based on the search results, Para. 0060-0066; because all the agent's information is accessible via hyperlinks, it is understood that the knowledge types are directly linked to one another; see also Para. 0056 & 0057) [Claims 10, 29, & 48].

13. Ghosh discloses wherein the knowledge types include a descriptive text area (The system enables the agent to obtain the requirements for getting a particular license, Para. 0014; For example, an agent profile is accessible by selecting "Agent" at user screen and instituting a

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search by first or last name, social security number or employee ID. The user can select and edit agent profile, or add an entirely new profile. Once the user has access to agent profile, the various fields of agent profile are then available for editing or data entry, Para. 0056, see also Figure 8; The user screen in Figure 8 is understood to be an area containing text describing licensing requirements; see also agent CE details and state CE requirements, Para. 0065) [Claims 11, 30, & 49].

14. Ghosh discloses embedding in at least one of the knowledge type one of: regulatory links (A user can view the various state CE requirements (requirements specific to various state authorities} through LIS and obtain reports or printouts of the requirements, Para. 0071), training links (LIS can inform agents about certified CE providers and instruction schedules to permit the agents to met the new requirements, Para. 0071) and a compliance link (LIS can also send to the agent or agents a current list of CE providers that are certified by the state to facilitate meeting any outstanding CE requirements, Para. 0071; see also tracking state specific criteria for licensing, Para. 0072) within the descriptive text area (State CE requirements are accessed on an appropriately named screen, Para. 0071; see also other tracked requirements information in Para. 0072-0074) [Claims 12, 31, & 50].

15. Ghosh discloses providing business information management (agency details in agency profile, Para. 0045-0053; also, a particular user, whether an agent, *agency owner*, insurance carrier or an entity needing insurance services, can access LIS to obtain information necessary to meet the needs of their particular business, Para. 0057) [Claims 16, 35, & 54].

16. Ghosh discloses wherein the profile is created employing the business information management (Agency details includes information about a particular agency such as its profile, present license status, appointments, officers and reports filed. The information in agency

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details is used by LIS to verify a match for a particular agency to provide services in a given state or in a particular area of insurance services, Para. 0034) [Claims 17, 36, & 55].

17. Ghosh discloses wherein the providing of business information management includes providing notification, wherein the notification includes at least one of: a dialog to users communicating updates to compliance knowledge, a dialog to users communicating additional training requirements, a dialog to users communicating upcoming examination, and a dialog to users communicating continuing education requirements (updates to the system information which causes changes in particular data items will initiate a section of executable code which provides a response to the change, Para. 0059; Agents that lack particular CE training required by a state for which a license will be obtained or maintained are notified automatically, through any regular media including mail and e-mail, Para. 0071; automatic particular CE notification via email is understood to be a dialog to a user communicating at least additional training requirements, upcoming examination, and CE requirements) [Claims 18, 37, & 56].

18. Ghosh discloses generating knowledge use data associated with use of the provided personalized business information (LIS reacts to entry or modification of information in agent details or agency details by analyzing the changes and initiating proactive measures designed to contribute to keeping agent and agency licenses current, Para. 0058) [Claims 58, 63, & 68].

19. Ghosh discloses recording [Claims 59, 64, & 69] and storing [Claims 60, 65, & 70] the recorded knowledge use data (Modifications to the information in agent details or agency details may be requested by an agent upon a change in status by e-mail, postal mail, or automatically by receipt of a notification from a licensing authority, such as a state insurance department, Para. 0058) [Claims 59, 60, 64, 65, 69, & 70].

20. Ghosh discloses generating documents based on the recorded knowledge use data (Reports in LIS are also available to satisfy agent and agency reporting requirements. Report

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details can contain form reports which are populated with data through a query to the updated system components. At a user command, or if set for automatic generation, reports are created for submission to appropriate state authorities to satisfy various requirements, Para. 0075-0077) [Claims 61, 66, & 71].

21. Ghosh discloses providing updated personalized business information based on the amount of personalized business information completed (As updates to the requirements promulgated by an individual state are released, LIS is modified to reflect the changes. Changes in state CE requirements or certified providers of CE instruction will prompt LIS to inform agents affected by the changes of the new requirements and provide the agents with ways in which the new requirements may be met. For example, LIS can inform agents about certified CE providers and instruction schedules to permit the agents to meet the new requirements, Para. 0071; see also Para. 0059) [Claims 62, 67, & 72].

#### ***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

23. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

24. Claims 7, 8, 13, 26, 27, 32, 45, 46, & 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghosh et al.

25. Ghosh teaches all the features of claims 1-6, 20-25, & 39-44, as demonstrated above.

What Ghosh fails to explicitly teach is storing the generated documents in a database [Claims 7, 26, & 45], and wherein the storing of generated documents includes obtaining a second set of administrative instructions [Claims 8, 27, & 46]. However, Ghosh teaches allowing users to access system components through requests to a relational database management system via a user interface, which then responds with reports and updated information (Para. 0026). Ghosh further teaches automatically generating reports, based on results of database queries (Para. 0075-0077) and storing user-specific report generation details (administrative instructions) in a database (Para. 0055), and automatically submitting reports to state authorities (Para. 0076). The invention of Ghosh would have been capable of storing the entire report in the database, instead of merely storing the report details, if the size of the database is unlimited, as well as obtaining report details in the database to store the instructions determining which reports are to be submitted to which authorities, and when. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the database of Ghosh to have stored his generated documents and obtaining a second set of administrative instructions for storing generated documents in a database, in order to reduce the time needed to produce and submit a report that was previously generated by temporal locality of reference [Claims 7, 8, 26, 27, 45, & 46].

26. What Ghosh further fails to explicitly teach is embedding in the first segment of information an object operable to initiate communication with at least one other user [Claims 13, 32, & 51]. However, Ghosh teaches a distributed system capable of being used by a number of users at a number of remote locations, and being interconnected with other related systems to

provide information transfer capabilities (Para. 0016). Ghosh further teaches using the Internet to send messages and responses (Para. 0029). Ghosh further teaches embedding information in a report which draws on information distributed across a network (Para. 0077). The invention of Ghosh would have been capable of embedding a link in a report causing a mail message to another agent, agency, or other user to be initiated. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the invention of Ghosh for embedding in the first segment of information an object operable to initiate communication with at least one other user, in order to use the reports to automatically appraise individuals of agencies of information which should be updated or for which action may be taken [Claims 13, 32, & 51].

#### ***Response to Arguments***

27. Applicant's arguments filed 12/5/2008, see pages 16-18, have been fully considered but they are not persuasive. Ghosh clearly teaches identifying employer business information requirements for respective user job functions (various entities requiring insurance services can access the several databases of the present invention to verify that a particular agent meets the requirements for their needs, or to locate an agent which meets all the requirements that the particular entity has in mind. The system is designed to capture information for tracking licensing requirements for both insurance and securities businesses, Para. 0015) wherein the employer business information requirements for respective user job functions is information for use in performing the respective user job functions as determined by an employer (insurance agents are required to be licensed in each state in which they conduct business, Para. 0006). In the instant case, a specific business entity is an insurance agency. It is clear from Ghosh at Paras. 0006-11 that, in order for an agent to do business in a state, the agent must meet all the

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requirements for each of those states, to ensure that their licensing status is maintained. Thus, where the employer requires an agent to maintain a license for a particular state, in order to do business, the information pertaining to the state requirements, such as CE compliance, etc. would be identified by Ghosh for performing the agent's function as a broker of insurance. Therefore, Ghosh is understood to meet the limitation.

28. The reply filed on 12/5/2008 is further not fully responsive to the prior Office Action because of the following omission(s) or matter(s): there is no traversal or amendment addressing either the objection to claim 66 or the rejection of claims 8, 27, & 46 under 35 USC §112, second paragraph. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, Applicant is obligated to respond to these deficiencies in the next response.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolai A. Gishnock whose telephone number is (571)272-1420. The examiner can normally be reached on M-F 8:30a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

2/5/2009

/N. A. G./  
Examiner, Art Unit 3715

/XUAN M. THAI/  
Supervisory Patent Examiner, Art Unit 3715